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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/913,325	08/10/2001	Martin Gleave	UBC:P-020	8469
21121	7590	01/12/2006	EXAMINER	
OPPEDAHL AND LARSON LLP			VIVLEMORE, TRACY ANN	
P O BOX 5068			ART UNIT	
DILLON, CO 80435-5068			PAPER NUMBER	

1635

DATE MAILED: 01/12/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/913,325

Applicant(s)

GLEAVE ET AL.

Examiner

Tracy Vivlemore

Art Unit

1635

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 October 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-17 and 24-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4,6,24,25 and 27 is/are rejected.
- 7) ☒ Claim(s) 3,5,7-17,26 and 28-34 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date: _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date: _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

Any rejection not reiterated in this Action is withdrawn.

Response to Arguments Claim Rejections - 35 USC § 112

Claim 6 remains rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement for the reasons of record.

Applicant has argued that the examiner has likened the instant claims to those present in *Rochester v Searle* to “the extent the claims antisense as the active agent”. Clarification is requested because antisense agents have not been rejected as lacking written description.

Applicant argues they have discovered that limiting the expression of TRPM-2 has therapeutic benefits and that this is reflected in the instant claims. Applicant’s reasoning that the discovery that antisense oligonucleotides have a therapeutic benefit would thus provide description of all inhibitors of TRPM-2 would mean they have provided description of all inhibitors of TRPM-2, including those yet to be discovered.

Applicant argues the examiner’s position with regard to written description would have the effect of delaying disclosure so additional therapeutic agents can be tested or allow others to steal the inventor’s work and the examiner has not provided reasons why this is desirable. These arguments are not persuasive because conjecture

regarding what an applicant might do in the future is not directed to the grounds of rejection.

Response to Arguments - Claim Rejections - 35 USC § 102/35 USC § 103

Claims 1, 2, 4, 24, 25 and 27 remain rejected under 35 U.S.C. 102(b) as being anticipated by or, in the alternative, under 35 U.S.C. 103(a) as obvious over Sensibar et al.

Applicant argues the tests of Sensibar et al. did not last for a period of time necessary for the cells to progress to androgen independence and that the reference of Sensibar et al. is merely "accidental anticipation". This is not persuasive because arguments regarding the time period of experiments are directed to limitations not present in the claims. Additionally, applicant's arguments are directed to the intended use of the method, which does not have patentable weight. MPEP 2112.02 states, "when the claim recites using an old composition or structure and the "use" is directed to a result or property of that composition or structure, then the claim is anticipated". Sensibar et al. discloses the claimed step and thus anticipates the instant claims.

Allowable Subject Matter

Claims 3, 5, 7-17, 26 and 28-34 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tracy Vivlemore whose telephone number is 571-272-2914. The examiner can normally be reached on Mon-Fri 8:45-5:15.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang can be reached on 571-272-0811. The central FAX Number is 571-273-8300.

Patent applicants with problems or questions regarding electronic images that can be viewed in the Patent Application Information Retrieval system (PAIR) can now contact the USPTO's Patent Electronic Business Center (Patent EBC) for assistance. Representatives are available to answer your questions daily from 6 am to midnight (EST). The toll free number is (866) 217-9197. When calling please have your

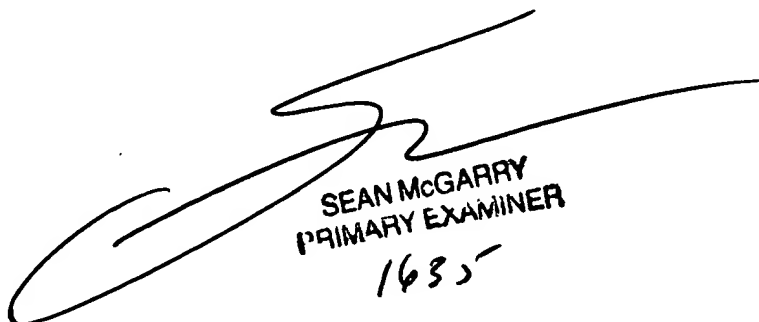
Art Unit: 1635

application serial or patent number, the type of document you are having an image problem with, the number of pages and the specific nature of the problem. The Patent Electronic Business Center will notify applicants of the resolution of the problem within 5-7 business days. Applicants can also check PAIR to confirm that the problem has been corrected. The USPTO's Patent Electronic Business Center is a complete service center supporting all patent business on the Internet. The USPTO's PAIR system provides Internet-based access to patent application status and history information. It also enables applicants to view the scanned images of their own application file folder(s) as well as general patent information available to the public. For more information about the PAIR system, see <http://pair-direct.uspto.gov>.

For all other customer support, please call the USPTO Call Center (UCC) at 800-786-9199.

Tracy Vivlemore
Examiner
Art Unit 1635

TV
January 6, 2006



SEAN MCGARRY
PRIMARY EXAMINER
1635